

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/298,910
ATTORNEY DOCKET NO. Q54131

REMARKS

Claims 10, 12, 14, 16 and 17 have been examined on their merits.

Applicant herein amends claims 10, 12, 14, 16 and 17 to more clearly recite that a dialing signal is transmitted to a base station control station or an exchange each time a key on a dialing pad is pressed. Support for the amendment to claims 10, 12, 14, 16 and 17 can be found, for example, in Figures 3 and 4 of the instant specification.

Claims 10, 12, 14, 16 and 17 are all the claims presently pending in the application.

1. Claim 16 stands rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being indefinite. Applicant has amended claim 16 to clarify that the dialing signals are sent to the base station control station through a base station, but the base station decides if a received dialing signal is the final digit of a telephone number. Applicant respectfully requests that the Examiner withdraw the § 112 (2nd para.) rejection of claim 16.

2. Claims 10 and 16 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Bilgic *et al.* (U.S. Patent No. 5,884,148). Applicant traverses the rejection of claims 10 and 16 at least for the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art

reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

With respect to claims 10 and 16, Bilgic *et al.* fail to teach or suggest transmitting single digit dialing signals to a telephone exchange or a base station control station as each single digit dialing signal is generated. Instead, Bilgic *et al.* disclose, *inter alia*, that dialing signals, such as DTMF tone signals or pulse signals, are generated by the telephone or CPE. *See, e.g.*, col. 9, lines 1-4 of Bilgic *et al.* The base station stores the dialed signals (the numbers dialed) and formats them appropriately according to the numbering plan of the locality in which the base station is situated. *See* col. 9, lines 42-46; col. 11, lines 38-48; Fig. 3, steps 311-320 of Bilgic *et al.* Once all of the numbers have been dialed, the base station inserts the entire string of numbers at a call setup message that transmits all of the numbers at once to the base station controller. *See* col. 12, lines 49-55; Fig. 4A, service request message 420 of Bilgic *et al.* In other words, the base station sends all of the dialing signals to the base station controller all together at one time.

Based on the foregoing reasons, Applicant submits that Bilgic *et al.* fail to disclose all of the claimed elements as arranged in claims 10 and 16. Therefore, under *Hybritech* and *Richardson*, Bilgic *et al.* clearly cannot anticipate the present invention as recited in independent

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claims 10 and 16. Thus, Applicant submits that claims 10 and 16 are allowable. Applicant respectfully requests that the Examiner withdraw the § 102(e) rejection of claims 10 and 16.

3. Claims 12, 14 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bilgic *et al.* in view of Suonvieri (U.S. Patent No. 6,047,181). Applicant traverses the rejection of claims 12, 14 and 17 at least for the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior

art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Examiner acknowledges that Bilgic *et al.* do not disclose or suggest a base station comprising means for deciding whether a dialing signal represents a final digit of a dialed telephone number or not. The Examiner suggests that Suonvieri allegedly discloses the subject matter to overcome the acknowledged deficiencies of Bilgic *et al.*

With respect to claims 12, 14 and 17, the combination of Bilgic *et al.* and Suonvieri fail to teach or suggest transmitting single digit dialing signals to a telephone exchange or a base station control station as each single digit dialing signal is generated. As discussed above with respect to claims 10 and 16, Bilgic *et al.* do not disclose or suggest this feature. The disclosure of Suonvieri does overcome this fundamental deficiency of Bilgic *et al.*, as Suonvieri does not

discuss, and does not at all relate to the manner of transmission of dialing signals among different parts of a radio communications system. For instance, the Examiner's citation to Suonvieri (col. 5, lines 19-39) does not relate to deciding whether a dialing signal represents a final digit of a dialed telephone number, as the claims require. Rather, Suonvieri describes how the dynamic changing of timing advance ranges in and among cells in a cellular telephone network can be done by either the base station or the base station controller. *See* col. 5, lines 31-38 of Suonvieri. In sum, Suonvieri is totally unrelated to deciding whether a dialing signal represents a final digit of a dialed telephone number.

The Examiner argues that "it is not patentably distinct to take a known process and move it from the base station to the base station controller." Applicant requests that the Examiner provide a citation to Federal Circuit caselaw, citation,

Thus, Applicant believes that the Examiner cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Bilgic *et al.* nor Suonvieri disclose transmitting single digit dialing signals to a telephone exchange or a base station control station as each single digit dialing signal is generated, Applicant submits that one of skill in the art would not be motivated to combine the references. *In re Dembiczak* and *In re Zurko* require the Examiner to provide particularized facts on the record as to why one of skill would be motivated to combine the references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308

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(Fed. Cir. 1999). The Examiner must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). One of ordinary skill in the art would not have been motivated to combine these references in the manner suggested by the Examiner, because they teach unrelated technologies. For example, Bilgic *et al.* is directed to connecting a standard non-wireless device with a wireless system, while providing flexibility with respect to the telephone numbering scheme and dialing signal analysis of the systems geographic location. *See* col. 2, lines 29-36 of Bilgic *et al.* In contrast, Suonvieri relates to intracell capacity allocation and intracell handover in conventional cellular telephone systems. *See* col. 1, lines 11-14 of Suonvieri. There is no overlap in the teachings of the inventions of these references, and no suggestion in either reference that would motivate combining one with the other. In particular, the invention of Suonvieri has no need for connecting a standard non-wireless device with a wireless system, because it relates solely to connecting conventional wireless devices together. Thus, Applicant submits that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

The Examiner argues that “it is not patentably distinct to take a known process and move it from the base station to the base station controller.” Applicant requests that the Examiner provide a citation to a Federal Circuit case, a section of Title 37 of the Code of Federal Regulations or the MPEP that supports the Examiner’s argument. The Examiner is obligated by *In re Zurko* and *In re Lee* to provide the reasoning that supports the obviousness rejections. Otherwise, the claim rejection is improper.

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Based on the foregoing reasons, Applicant submits that the combination of Bilgic *et al.* and Suonvieri fails to disclose all of the claimed elements as arranged in claims 12, 14 and 17. Therefore, the combination of Bilgic *et al.* and Suonvieri clearly cannot render the present invention obvious as recited in claims 12, 14 and 17. Thus, Applicant submits that claims 12, 14 and 17 are allowable, and respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 12, 14 and 17.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER


Paul J. Wilson
Registration No. 45,879

Date: February 18, 2004